



PATENT
Customer No. 22,852
Attorney Docket No. 06502.0340-00000

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:)
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Michael SIJACIC et al.) Group Art Unit: 3627
)
Serial No.: 09/867,652) Examiner: S. McAllister
)
Filed: May 31, 2001) Confirmation No.: 7976
)
For: METHODS AND SYSTEM FOR)
PERFORMING ELECTRONIC) **Mail Stop After-Final**
INVOICE PRESENTMENT AND)
PAYMENT DISPUTE HANDLING)
WITH LINE ITEM LEVEL)
GRANULARITY)

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Applicants request a pre-appeal brief review of the Final Office Action dated May 19, 2005. This Request is being filed concurrently with a Notice of Appeal and a two-month extension of time fee payment.

I. Requirements For Submitting a Pre-Appeal Brief Request for Review

Applicants have met each of the requirements for a pre-appeal brief review of rejections set forth in an Office Action. The application has been at least twice rejected. Applicants have filed a Notice of Appeal with this Request, and has not yet filed an Appeal Brief. Lastly, Applicants submit a Pre-Appeal Brief Request for Review that is five (5) or less pages in length and sets forth legal or factual deficiencies in the rejections. See Official Gazette Notice, July 12, 2005. Therefore, Applicants request review of the Examiner's rejections in the Final Office Action for the following reasons.

II. The Examiner is Legally Incorrect in Asserting Claims 1, 3, 4, 7-13, 21, 23, 31, 32, and 34 are Directed Towards Non-Statutory Subject Matter

In the Final Office Action, the Examiner asserted claims 1, 3-14, 21, 23, 31, 32, and 34 “were directed towards non-statutory subject matter because “they lack a technological element.” In particular, the Examiner suggested the claims required “a recitation of a computer in the body of the claims” to provide a “nexus” between the “computer-implemented” recitation in the preamble of these claims. As noted by Applicants in the Amendment filed August 1, 2005 (“the Amendment”), the Examiner ignores the “providing entity” and “purchasing entity” recited in the body of these claims. (See the Amendment at 30-31.) As explained, each of these entities are described by Applicants as including, *inter alia*, a CPU system. (*Id.* at 31.) Moreover, Applicants pointed out in the Amendment that the Federal Circuit has rejected the notion that “all processes, to be patentable, must operate physically upon substances.” (*Id.*) As such, Applicants request reconsideration of the Examiner’s rejection of these claims under 35 U.S.C. § 101.

III. The Examiner is Legally Incorrect in Asserting Claims 1, 3, 4, 7-9, 31, 32, and 34 Fail to Comply with the Written Description Requirement

The Examiner is incorrect that Applicants’ specification fail to describe a first approver making a decision based on the fact that the items have been previously reviewed.” (Final OA at 32.) As explained in the Amendment, Applicants’ specification at [0106-0115] describe aspects of the inventions to show a first approver generating a decision based on an indication of line items having been reviewed by other approver(s). (See the Amendment at 32.) Indeed Applicants directed the Examiner to examples described by the specification. (*Id.*) Accordingly, it is clear Applicants’ specification describes aspects that describe an approver receiving an indication of a previously reviewed line item, such as shown in Figs. 10 and 11. Thus, when overriding or approving a decision by another approver, the “first” approver does so based on an indication that the other approver has reviewed the line item. Also, as explained in the Amendment, the Examiner is incorrect in asserting the specification does not support claims 7-9. (Final OA at 4.) As argued by Applicants, the Examiner improperly focuses on one possible aspect of Applicants’ invention, while ignoring others that describe the features recited in these claims. (See the Amendment at 32-33.) Further, as mentioned

above, Applicants pointed the Examiner to the portions of the specification that show support for claims 31 and 32. (See the Amendment at 33.)

Although Applicants explained in detail how the specification provides support for the pending claims, the Examiner continues to ignore these arguments. Instead, the Examiner merely states in the Advisory Action that the “remaining claims are rejectable under the previous rejection of 5/19/2005” without addressing the portions of the specification pointed out by Applicants. (Advisory Action, 9/12/05.) Accordingly, Applicants request reconsideration of the rejections under 35 U.S.C. § 112, first paragraph in light of the arguments set forth in the Amendment. (See, e.g., the Amendment at 32-33.)

IV. The Examiner is Legally Incorrect in Asserting Claims 7-9 are Indefinite

The Examiner improperly applies 35 U.S.C. § 112, second paragraph to reject claims 7-9 by asserting “it is not clear what these entities are intended to be;” referring to the first and second processing entities recited in claims 7-9 (Final OA at 5.) As noted in the Amendment, M.P.E.P. § 2173.04 indicates breadth is not indefiniteness. (See the Amendment at 34.) That is, the fact that Applicants chose to use the phrase “processing entity” in these claims does not per se make the claims indefinite as Applicants are entitled to be their own lexicographer. Indeed, as noted in the Amendment, the term “entity” is described in various aspects of Applicants’ invention, such as “purchasing entity 220A” and “providing entity 210A” described in connection with Fig. 2A. (See the Amendment at 34-35.) Accordingly, Applicants request reconsideration of the Examiner’s position to reject claims 7-9 under 35 U.S.C. § 112, second paragraph as set forth in the Final Office Action.

Regarding claims 32 and 34, as noted in the Amendment, the restriction applied by the Examiner has precluded Applicants from correcting the minor deficiencies identified by the Examiner. (See the Amendment at 35.)

V. The Rejection of Claims 1, 3, 4, 7-13, 21-23, 31, 32, and 34 under 35 U.S.C. § 103(a) is Legally Deficient

The Examiner’s rejections of these claims under 35 U.S.C. § 103(a) are legally deficient at least because (1) the Examiner fails to describe how or where the cited art discloses the asserted recitations as required under 37 C.F.R. § 1.104, and (2) the Examiner does not show a proper suggestion to combine the references as required under M.P.E.P. § 2143.

To establish a *prima facie* case of obviousness, the Examiner must show, among other things, the prior art reference or references, taken alone or combined, must teach or suggest each and every element recited in the claims. (See M.P.E.P. § 2143.03.) In rejecting claims 1, 3, 4, and 10-13 under 35 U.S.C. § 103(a), the Examiner admits *Randell '127* (via *Remington*) does not “performing a dispute resolution process between the purchaser and provider in response to an indication that a line item has not been approved.” (Final OA at 7, ll. 5-7.) To satisfy this deficiency, the Examiner merely asserts “‘332 shows this step.” (Final OA at 7, ll. 7-8.) The Examiner follows the same format in rejecting claims 3, 4, and 10-13 (Final OA at 4-5). The same problems are present in the rejections of claims 7-9, and 21-23. (See, e.g., Final OA at 9, ll. 18-19.) That is, the Examiner merely concludes the cited reference(s) teach a given recitation, yet offers no evidence in the office action to support the conclusions. Further, in rejecting claims 12 and 31 under 35 U.S.C. § 103(a), the Examiner relies on personal knowledge. (Final OA at 8 and 12.) Accordingly, Applicants request the Examiner support the personal knowledge asserted in the rejection with a corresponding affidavit, pursuant to 37 C.F.R. § 1.104(d)(2).

As explained in the Amendment, 37 C.F.R. § 1.104(c) requires the Examiner to provide more than merely stating a reference meets the limitations, and nothing more. (See the Amendment at 35.) “When a reference is complex or shows or describes inventions other than that claimed by the applicant, the particular part relied on must be designated as nearly as practicable. The pertinence of each reference, if not apparent, must be clearly explained and each rejected claim specified.” 37 C.F.R. § 1.104(c)(2). In this case, not only are the references asserted by the Examiner complex and describe many different embodiments, including the ‘332 reference (i.e., *Gonen-Friedman*). As such, the Examiner’s rejection of Applicants’ claims under 35 U.S.C. § 103(a) does not meet the requirements of 37 C.F.R. 1.104, and thus is improper.

Additionally, the Examiner has not established a *prima facie* case of obviousness in rejecting claims 1, 3, 4, 7-13, 21-23, 31, 32, and 34. To establish a *prima facie* case of obviousness, among other things, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to combine the references in a manner resulting in the claimed invention. See M.P.E.P. § 2143. The Examiner failed to meet at least this requirement.

The Examiner's reasons for combining the asserted reference(s) are conjecture. For example, in rejecting claim 1, the Examiner does not offer a reason for making the asserted combination other than "to resolve billing disputes." Nowhere does the Final Office Action show where "in the references themselves" or "in the knowledge available to one of ordinary skill in the art" there is a proper motivation. Instead, the Examiner concludes it would be obvious to combine the cited art based on the what the Examiner alleges is taught by the supporting reference (e.g., '332 Patent). This reasoning does not meet the standard for establishing a *prima facie* case of obviousness.

The Examiner follows a similar practice in rejecting claim 10 (Final OA at 8, ll. 4-7); claim 13 (Final OA at 8, ll. 17-19); claims 7-9 (Final OA at 9-10); and claim 21 (Final OA at 10, ll. 10-13). Moreover, in rejecting claim 12 in view of "'127/Remington" and "'332," the Examiner offers no suggestion or reasons for combining the references. (Final OA at 9.)

Also, as noted in the Amendment, the Examiner has not properly addressed the recitations of claim 10 when rejecting the claim. (See the Amendment at 36-37.) Accordingly, Applicants request reconsideration of the rejection of this claim in light of the Examiner's mischaracterization of the recitations of the claim.

In light of the above arguments and those presented in the Amendment, Applicants submit that the Examiner failed to establish a *prima facie* case of obviousness in rejecting claims 1, 3, 4, 7-13, 21-23, 31, 32, and 34 under 35 U.S.C. § 103(a). Therefore, the rejections should be withdrawn and the claims allowed

V. Conclusion

As explained in the above remarks, the Final Office Action includes legal deficiencies with regard to the rejections under 35 U.S.C. § 101, 112, and 103. As such, Applicants respectfully request that the rejection of these claims be reconsidered, withdrawn, and the claims allowed.

Respectfully submitted,

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Dated: October 14, 2005

By: 

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